

## **REMARKS**

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the instant Amendment, Claims 1-4, 6, 9-18, and 21-42 will be all of the claims presently pending before the Examiner. Instantly, Claims 1, 4 and 18 are amended, Claims 5, 19, and 20 are canceled without prejudice, and Claims 40 and 41 are newly added. Of the pending claims, Claims 1, 40 and 41 are independent claims, while the remaining claims are dependent claims.

Applicants respectfully submit that no new matter has been added by the present amendments. Support for the amendments can be found generally throughout the Applicants' disclosure. It should also be noted that this Amendment is not in acquiescence of the Office's position on the allowability of the claims but made merely to expedite prosecution.

The Office is, therefore, respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

### **I. Claim Rejections**

#### **A. 35 U.S.C. 112**

Claim 18 is rejected as being indefinite. Applicants respectfully submit Claim 18 has been amended and is now definite. The rejection should now be withdrawn.

#### **B. 35 U.S.C. 102(b)**

Claims 1-6, 9-19, 21-23, 25-33 and 35-39 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Obrecht et al., USPN 6,399,706 (hereinafter "Obrecht"). Applicants traverse said rejections for the following reasons and request their withdrawal.

As best understood, Obrecht "[r]elates to the addition of sulfur-containing

organosilicon compounds to microgel-containing rubber compounds and to vulcanized materials which are produced therefrom." (Col. 1, Lines 6-9) As shown in Example 4 of Obrecht, there is included in one embodiment stearic acid and Vulkanox® 4010NA(N-isopropyl-N'-phenyl-p-phenylenediamine)(hereinafter "IPPD").

The Office opines that the stearic acid and/or IPPD teach the claimed "[a]t least one non-crosslinkable organic medium (A)." (Office Action, Page 3)

Instantly, the claims have been amended to now provide "10 to 99.9 wt.% of at least one non-crosslinkable organic medium (A) based on the total amount of the composition." (Independent Claims 1 and 40) As such, the presently claimed non-crosslinkable organic medium is present in an amount clearly outside the teaching and suggestion of Obrecht. As known to the skilled artisan, the use of stearic acid and IPPD as provided in Example 4 of Obrecht is as a vulcanization add and anti-oxidant, respectively. Moreover, in these uses the amount present is always very small as compared to the total amount of the composition. Therefore, Obrecht's teaching stearic acid and IPPD fails to anticipate the presently claimed invention, since at the very least, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

In light of the present shortcomings of the cited reference, it is respectfully requested that the present rejections be withdrawn.

Applicants also note, newly added independent Claims 40 and 41 overcome Obrecht's teachings for, at minimum, those reasons as described above.

C. 35 U.S.C. 102/103

Claim 24 is rejected 35 U.S.C. 102(b) as being allegedly anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over, Obrecht et al., USPN 6,399,706 (hereinafter "Obrecht").

Applicants traverse the rejection for the reason provided above and request its

immediate withdrawal.

D. 35 U.S.C. 102/103

Claims 1-4, 12, 14, 16, 18-24, 27-28, 30, and 33-37 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over, Yamamoto et al., USPN 6,548,454 (hereinafter "Yamamoto"). Applicants respectfully disagree for the reasons to follow.

As best understood, Yamamoto relates to a "rolling apparatus" in which a lubricating composition is employed. The disclosed lubricating composition appears to be "[a] mixture of (1) a thickening agent which is at least one selected from the group consisting of a solid fluoropolymer, a lamellar mineral powder, an ultrafinely particulate organic material, an organic solid lubricant and an ultrafinely particulate inorganic material, and (2) a base oil comprising a liquid fluorinated polymer oil." (Abstract) The "ultrafinely particulate organic material" is said to possess a microgel structure. (Col. 15, Lines 27-30) As taught by Yamamoto, this ultrafinely particulate organic material is mixed with a base oil to form a lubricant composition of the invention. (E.g., Col. 15, Lines 14-17) As indicated above, the base oil of the Yamamoto invention is limited to liquid fluorinated polymer oils. (E.g., Abstract; Col. 16, Lines 26-27).

Firstly, regarding the rejected claims, Applicants have now amended them to provide, *inter alia*, "[a] deviation between the diameters of the individual primary particles is less than 250 %, where said deviation is defined as being equal to formula (I) [ (d1 – d2) / d2 ] x 100 (I), where d1 and d2 are each a diameter of the individual primary particles measured and where d1 is greater than d2." (Claim 1) As the Examiner is aware, sections 102 and 103 require the prior art reference teaches or suggests all the claim's limitations, respectively. Yamamoto clearly fails to disclose or to even suggest a composition comprising microgels having a deviation of particle diameter as presently claimed. Therefore, the present rejections should be withdrawn.

Secondly, with respect to newly added Claim 40, Applicants note that the newly added claim recites, *inter alia*, "[w]herein the at least one non-crosslinkable organic

medium (A) is selected from the group consisting of: hydrocarbons, polyether oils, ester oils, phosphoric acid esters, silicon-containing oils, and mixtures thereof, wherein said hydrocarbons are selected from the group consisting of C<sub>1</sub>-C<sub>200</sub>, natural, synthetic, non-substituted, substituted, straight-chain, branched, cyclic, saturated, unsaturated, aromatic, and mixtures thereof and wherein the substituted hydrocarbons is by a substituent selected from the group consisting of chlorine, hydroxyl, oxo, amino, carboxyl, carbonyl, aceto and amido."

In stark contrast to Yamamoto, the invention as provided in Claim 40 does not include a non-crosslinkable organic medium (A) being free of a liquid fluorinated polymer oil. As such, it is respectfully submitted independent Claim 40 is in condition for immediate allowance

Finally, with respect to newly added independent Claim 41, there is claimed, *inter alia*, "[w]herein the composition is in the form of a dispersion of the at least one microgel (B) in the non-crosslinkable organic medium (A) and wherein said dispersion comprises a division of individual primary particles within the non-crosslinkable organic medium (A)".

As is explained in the Applicants' disclosure, "The division of the microgels in the organic medium down to within the primary particle range is a prerequisite, for example, for rendering the nanoproperties of the microgels usable, in particular reproducibly, in any uses, for example in the case of incorporation into plastics," and that such dispersability of the microgels, "[s]how[s], surprisingly, properties comparable to those of commercial greases (stability towards settling out, low separation of oil, consistency etc.); however, they have more favorable properties in respect of e.g. shear stability (i.e. almost no change in the penetration values after milling with 60,000 strokes) and exceptionally high drop points such as are otherwise achieved only by heat-resistant greases, such as e.g. PU greases or Ca complex greases." (Page 3, Lines 3-8 and Lines 14-21)

In stark contrast to Yamamoto, the invention as provided in Claim 41 relates to finely dispersed microgel/organic media compositions and, as such, is in condition for immediate allowance

## II. Conclusion

In view of the foregoing, it is respectfully submitted that independent Claims 1, 40 and 41 are fully distinguishable over the applied art and are thus in condition for allowance. By virtue of dependence from what is believed to be an allowable independent Claim 1, it is respectfully submitted the remaining dependent claims are also presently allowable. Notice to the effect is earnestly solicited.

If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 CFR 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully,

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